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| SERIAL NUMBER | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 08/142,474 | 11/29/93 | JANSSENS F | JAB812PCTUS |

DATLOW, P EXAMINER

12M2/1005

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| ART UNIT | PAPER NUMBER |
|---|---|
| 1202 | 4 |

DATE MAILED: 10/05/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ~ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☑ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

**Part II SUMMARY OF ACTION**

1. ☑ Claims 1-5, 9, 11-20 are pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☑ Claims 1-4, 9, 11-14, 16-19 are rejected.
5. ☑ Claims 5, 15, 20 are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

1. Applicants are advised that certain claims contain brackets that are intended to appear in the printed patent. The brackets or underlining are not intended to indicate amendments or changes in the claims. Under these conditions, proposed amendments to the claims may not be made by underlining words added or by bracketing words to be deleted.

2. Claims 1-4, 9, 11-14 and 16-19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) In claim 1, the $Het^3$ definition given at pg. 73, lines 8-13 is confusing and indefinite. The language "4,5-dihydro-5-oxo-1H-tetrazolyl substituted with . . . alkyl, 2-oxo-3-oxazolidinyl, 2,3-dihydro-2-oxo . . . or a radical of the formula . . ." is confusing. It is not clear whether the groups listed after "4,5-dihydro-5-oxo-1H-tetrazolyl substituted with . . . alkyl" are other substituents on the 4,5-dihydro-5-oxo-1H-tetrazolyl group or are intended to be separate $Het^3$ groups. The scope of the claim is uncertain.

2) In claim 1, last line, the term "ecxluded" is incorrect for the intended term "excluded".

3) In claim 3: At pg. 73, line 30, the phrase "amino,pyridinyl" is grammatically incorrect and confusing; At pg. 73, line 31, the phrase "each optionally substituted with

hydroxy" is confusing since it is unclear what "each" refers to - just the pyrimidinyl or other groups previously listed; Also, the Het definitions at pg. 73, lines 29-32 should be presented in the alternative "or", not "and" as at line 31.

4) In claim 9, pg. 75, lines 17-18, the nomenclature of the excluded compound appears incorrect. The nomenclature " . . . imidazol[1,2-b][3]benzazepine . . ." should be "imidazo[2,1-b][3]benzazepine" to conform with the claimed structure of formula (VII).

3. The claims for benefit under 35 USC 120 are noted. The parent U.S. applications Serial Nos. 07/714486 and 07/853631 have been carefully reviewed. These cases are insufficient to provide for proper support under 35 USC 112, 1st paragraph, for the instantly claimed subject matter, and therefore benefit cannot be accorded to those cases under 35 USC 120. Note that the full scope of the instantly claimed groups $R^1$, $R^3$, $R^5$, L and Q are not described or enabled in the parent cases. Further, it does not appear that all the species in claim 5 are described in the parent cases. If applicants dispute these findings, they are requested to specifically point out where proper support for the instant claims can be found in the parent cases. Thus, the instant effective filing date is determined to be 6/9/1992, the international filing date.

4. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claim(s) 1, 3-4, 11, and 13-14 are rejected under 35 U.S.C. ✓ § 103 as being unpatentable over WO 92/06981. WO '981 teaches a generic group of compounds which embraces applicant's claimed compounds. See formula 3.0 at pgs. 8-9, which are taught as intermediates in the preparation of the disclosed compounds of formula 1.0, pg. 1, where Q is CH, and n is 1. The claims differ from the reference by reciting specific species and/or a more limited subgenus than the reference. However, it would have been

obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as taught for the genus as a whole, i.e., as intermediates useful to prepare the pharmacological compounds of formula 1.0. One having ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claim 9 is rejected under 35 U.S.C. § 102(a) as being anticipated by WO 92/06981. See the compound listed at pg. 23, lines 23-24 which has the formula given as E at pg. 3 (bottom). See instant claim where all the R groups are hydrogen and Q is acetyl. Note that the language at the last two lines of claim 9 is insufficient to exclude this compound taught in the WO reference. (see the rejection under 35 USC 112, 2nd par. above)

Claim(s) 9 is rejected under 35 U.S.C. § 103 as being

unpatentable over WO 92/06981. WO '981 teaches a generic group of compounds which embraces applicant's claimed compounds. See Formula 1.0 at pg. 1, wherein Q is CH , n is 1, Z is O, $R^1$ is alkyl or alkoxy. These compounds are taught as useful pharmacological agents. See abstract. The claims differ from the reference by reciting specific species and/or a more limited subgenus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as taught for the genus as a whole, i.e., as useful pharmacological agents in the treatment of allergies or asthma. One having ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole.

Note that many of the compounds embraced by claim 9, are mere ring alkylated derivatives of compound E in the WO reference, pg. 3 thereof. See where the instant R groups can be alkyl. Such structurally similar ring alkylated compounds would have been obvious to one having ordinary skill in the art, because such structurally similar compounds would be expected to share similar

pharmacological properties. See, e.g., In re Wood, 582 F.2d 638, 199 USPQ 137 (CCPA 1978); In re Lohr, 317 F.2d 388, 137 USPQ 548 (CCPA 1963).

7. Claims 5, 15 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The specifically claimed compounds in claims 5, 15 and 20 are not taught or suggested by the closest prior art of WO 92/06981.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Philip I. Datlow whose telephone number is (703) 308-4710.

PID

Philip I. Datlow
Patent Examiner
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